



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/578,137

05/03/2006

Hiroataka Minami

P71250US0

5226

136 7590 10/07/2009
JACOBSON HOLMAN PLLC
400 SEVENTH STREET N.W.
SUITE 600
WASHINGTON, DC 20004

EXAMINER

NUTTER, NATHAN M

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

10/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Amendment

In response to the amendment filed 9 January 2009 and the Substitute Specification filed 14 April 2009, the following is placed in effect.

The objection to the disclosure is hereby expressly withdrawn in view of the acceptable Substitute Specification and the statement under Rule 125.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yamanaka et al (US 5,314,941).

Note column 1 (lines 11-15), column 2 (line 54) to column 3 (line 40), column 4 (lines 35-46), the paragraph bridging column 4 to column 5, column 5 (lines 21-43) and Comparative Example 5 at column 6.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kushida et al (US 5,344,864).

Note the Abstract, column 1 (lines 7-25), at Table 1 the use of ChemigumTM, column 4 (lines 12-54), column 5 (lines 28-34), and the many Examples.

Art Unit: 1796

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Oshima et al (US 5,484,844).

Note column 1 (lines 7-11), column 3 (lines 33-59), column 4 (lines 8-56), column 5 (lines 7-37 and 50-59).

Response to Arguments

Applicant's arguments filed 9 January 2009 have been fully considered but they are not persuasive.

With regard to the rejection of claims 1 and 2 under 35 U.S.C. 102(b) as being clearly anticipated by Yamanaka et al (US 5,314,941), the reference teaches the identical constituents in identical compositional limitations as set out herein. The reference shows the production of the blend, as recited. When a reference discloses all of the limitations of a claim except a property or function, and the Examiner is unable to determine whether or not the reference inherently possesses properties that anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note *In re Fitzgerald et al* 619 F. 2d 67, 70, 205 USPQ 594, 596 (CCPA 1980). Note MPEP § 2112-2112.02. Further, it is pointed out that applicants' claims do not exclude other components, even in large amounts. Since the claims are drawn to a composition, the intended use as an "adhesive...for bonding" fails to elevate the claims to the level of patentability. Applicants have failed to show the reference composition to not possess the adhesive characteristics ascribed to the recitation "for bonding."

With regard to the rejection of claims 1 and 2 under 35 U.S.C. 102(b) as being clearly anticipated by Kushida et al (US 5,344,864), the reference teaches the identical

Art Unit: 1796

constituents in identical compositional limitations as set out herein. The reference shows the production of the blend, as recited. When a reference discloses all of the limitations of a claim except a property or function, and the Examiner is unable to determine whether or not the reference inherently possesses properties that anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant.

With regard to the rejection of claims 1 and 2 under 35 U.S.C. 102(b) as being clearly anticipated by Oshima et al (US 5,484,844), the reference teaches the identical constituents in identical compositional limitations as set out herein. The reference shows the production of the blend, as recited. When a reference discloses all of the limitations of a claim except a property or function, and the Examiner is unable to determine whether or not the reference inherently possesses properties that anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1796

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan M. Nutter/
Primary Examiner, Art Unit 1796

nmn

6 October 2009